

Application No.: 10/022,131
Amendment dated 9/23/03
Reply to Office Action of July 30, 2003

REMARKS

Claims 1-35 are pending in the application. By this Amendment, claim 1 has been amended to more particularly point out and distinctly claim the invention. Claims 8, 13, and 26 have been rewritten in independent form including all of the limitations of the base claim and any intervening claims, thus the scope of these claims remains unchanged. Also, claims 8-10 have been amended to change "external" to "exterior" as a purely cosmetic measure for improving consistency in claim terminology. No new matter has been added. Applicants expressly reserve the right to pursue broader claims and/or to appeal any or all rejections.

The acknowledgment, in the Office Action, of a claim for foreign priority under 35 U.S.C. § 119(a)-(d), is acknowledged with appreciation. However, the allegation that the certified copy of the priority document has not been received, is respectfully traversed as being contrary to fact. Submitted herewith is a Proof of Submission of Certified Copy of Priority Document, which is provided to overcome the allegation. Reconsideration and withdrawal of the allegation is respectfully requested.

To date, no Notice of Draftsperson's Patent Drawing Review has been received. Applicant respectfully requests receipt of this document when it becomes available.

Specification Objection

The Office Action has objected to the specification for an incorporation of essential material in the specification by reference to a foreign application. However, the material incorporated by reference is not presently considered to be "essential material" and, as a result, is not subject to the prohibition noted in the present Office Action. The purpose and basis for this incorporation by reference is further explained below.

If, during the course of prosecuting the present Application, a portion of the incorporated material is found to be necessary to support the claims or to provide adequate

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disclosure of the invention pursuant to 35 U.S.C. § 112, the present incorporation by reference would allow Applicant to amend the disclosure to include the material incorporated by reference without running afoul of the prohibition against adding new matter in 35 U.S.C. § 132. Should such a circumstance occur, Applicant would follow the procedure outlined by the Examiner of accompanying such an amendment by a supporting affidavit or declaration stating that the amending material consists of the same material incorporated by reference.

This approach is completely in accordance with the case cited in the present Office Action, *In re Hawkins*, 179 USPQ 157 (C.C.P.A. 1973). There, the Court of Customs and Patent Appeals (hereinafter "CCPA") held that where a foreign application (British) had been incorporated by reference in a U.S. application, the amendment of the U.S. application during prosecution to expressly include the material from British application is not new matter. See *Id.* at 162. Additionally, the CCPA held that the final determination of the adequacy of the specification as to whether it is enabling is measured at the issue date, not the filing date. Thus, if an originally submitted specification is not sufficient by itself to enable one skilled in the art to make and use the invention, the specification may be amended during prosecution--within the boundary set by 35 U.S.C. § 132--to make it enabling. See *Id.*

In the present case, Applicant does not presently believe that the foreign application contains "essential material" that would be necessary to add to the specification at this time. However, by incorporating the foreign application by reference, Applicant has preserved the opportunity, during prosecution, to amend the present specification in accordance with this material without incurring a new matter rejection should such an amendment be found necessary.

Therefore, it is respectfully requested that the objection to the specification be reconsidered and withdrawn.

Claim Objections

Claims 8-15, 26, and 30-35 are objected to as being dependent upon a rejected base claim, but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. By this Amendment, claims 8, 13, and 26 have been rewritten in independent form including all of the limitations of the base claim and any intervening claims, and therefore are considered to be in condition for allowance. Claims 9-12 depend from claim 8, and claims 14 and 15 depend from claim 13. Therefore, claims 9-12, 14, and 15 are considered to be allowable for at least the reason of depending from an allowable claim. Thus, rewriting claims 9-12, 14, and 15 would involve unnecessary expense and effort. With respect to claims 30-35, these claims depend from claim 27, which is considered to be in condition for allowance as discussed below. Thus, rewriting claims 30-35 would involve unnecessary expense and effort. Accordingly, it is respectfully requested that the objection to claims 8-15, 26, and 30-35 be reconsidered and withdrawn.

Rejections under 35 U.S.C. § 102

Watts

Claims 1, 2, and 5-7 presently stand rejected under 35 U.S.C. § 102(b) over Watts (U.S. Patent No. 4,813,717). Because this reference does not disclose all of the limitations of these claims, it is respectfully asserted that claims 1, 2, and 5-7 patentably distinguish over Watts.

Specifically, claim 1 (and claims 2 and 5-7, which depend from claim 1), as amended recites "said first and second mating surfaces are configured such that the joining member can be pushed into, and thereby locked into, the first axially extending passage."

This limitation is not disclosed by Watts. Watts discloses a tubular connection that includes a coupling and two pieces of tubing. The coupling has tapered external threads,

and can be screwed into one end of each piece of tubing having tapered internal threads. However, Watts does not show the pieces of tubing and the coupling having mating surfaces that can be pushed, and thereby locked, together. In other words, Watts fails to disclose "first and second mating surfaces ...configured such that the joining member can be pushed into, and thereby locked into, the first axially extending passage" as recited by claim 1. Therefore, since Watts fails to disclose all of the limitations of claim 1, Watts cannot anticipate claim 1, or claims 2 and 5-7 which depend from claim 1.

Accordingly, it is respectfully requested that the rejection of claims 1, 2, and 5-7 under 35 U.S.C. § 102(b) over Watts be reconsidered and withdrawn.

McCallion

Claims 1, 3, 4, and 27-29 presently stand rejected under 35 U.S.C. § 102(e) over McCallion (U.S. Patent No. 6,265,065 B1). Because this reference does not disclose all of the limitations of these claims, it is respectfully asserted that claims 1, 3, 4, and 27-29 patentably distinguish over McCallion.

With respect to claim 1 (and claims 3 and 4, which depend from claim 1), this claim as amended recites "said first and second mating surfaces are configured such that the joining member can be pushed into, and thereby locked into, the first axially extending passage."

These limitations are not disclosed by McCallion. McCallion discloses a piece of heat-shrinkable tubing for covering a welded joint where two reinforcement bars are welded end-to-end. The heat-shrinkable tubing is simply a cylindrical tube that can be heated to conform to the outer surface of the reinforcement bars. As such, the heat-shrinkable tubing has no mating surface such that a reinforcement bar can be "pushed into, and thereby locked into," the heat-shrinkable tubing. In other words, McCallion fails to disclose "first and second mating surfaces ...configured such that the joining member can be pushed into, and thereby locked into, the first axially extending passage" as recited by

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claim 1. Therefore, since McCallion fails to disclose all of the limitations of claim 1, McCallion cannot anticipate claim 1, or claims 3 and 4 which depend from claim 1.

With respect to claim 27 (and claims 28 and 29, which depend from claim 27), this claim recites:

A reinforced concrete sectional pile comprising:
...
a housing ...having a first interior surface ...and a second interior surface...
...
a joining member ...having an exterior surface,
wherein said first interior surface includes a first mating surface,
and said exterior surface includes a second mating surface,
wherein said first and second mating surfaces are configured such
that the second member can be inserted and thereby locked into the first
passage.

These limitations are not disclosed by McCallion. As discussed above with respect to claim 1, McCallion discloses a heat-shrinkable tubing that has no interior mating surface. Thus, McCallion fails to disclose that the heat-shrinkable tubing has an interior mating surface such that a reinforcement bar can be "inserted and thereby locked" into the heat-shrinkable tubing. Therefore, since McCallion fails to disclose all of the limitations of claim 27, McCallion cannot anticipate claim 27, or claims 28 and 29 which depend from claim 27.

Accordingly, it is respectfully requested that the rejection of claims 1, 3, 4, and 27-29 under 35 U.S.C. § 102(e) over McCallion be reconsidered and withdrawn.

Rejections under 35 U.S.C. § 103(a)

Claims 16-25 presently stand rejected under 35 U.S.C. § 103(a) over Watts in view of Chambers (U.S. Patent No. 5,406,983). Because the combination of Watts and Chambers does not disclose or suggest all of the limitations of claims 16-25, it is asserted that claims 16-25 are patentable over the cited art.

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Specifically, claim 1 (and claims 16-25, which depend from claim 1) as amended recites "said first and second mating surfaces are configured such that the joining member can be pushed into, and thereby locked into, the first axially extending passage."

These limitations are not disclosed or suggested by the cited art. As discussed above, Watts discloses a coupling having tapered external threads so the coupling can be screwed into an end of a piece of tubing having tapered internal threads. Similarly, Chambers discloses a coupling also having interior threaded surfaces. Thus, even if one skilled in the art were to consider the combination of the teachings of Watts and Chambers, the resulting combination would only teach the use of interior threaded surfaces. That is, the combination of Watts and Chambers would fail to disclose or suggest "first and second mating surfaces ...configured such that the joining member can be pushed into, and thereby locked into, the first axially extending passage" as recited by claim 1. Therefore, since the combination of Watts and Chambers fails to disclose or all of the limitations of claim 1, the combination of Watts and Chambers cannot render obvious claim 1, or claims 16-25 which depend from claim 1.

Accordingly, it is respectfully requested that the rejection of claims 16-25 under 35 U.S.C. § 103(a) over Watts in view of Chambers be reconsidered and withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment increases the number of independent claims by three from two to five, but does not increase the total number of claims or present any multiple dependency claims. Accordingly, a Response Transmittal and Fee Authorization form authorizing the amount of \$84.00 to be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260 is enclosed herewith in duplicate. However, if the Response Transmittal and

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Fee Authorization form is missing, insufficient, or otherwise inadequate, or if a fee, other than the issue fee, is required during the pendency of this application, please charge such fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any fee required for such Petition for Extension of Time, and any other fee required by this document, other than the issue fee, and not submitted herewith, should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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